

**Remarks**

In the Office Action, the Examiner rejects Applicants' claims 1-20 under 35 USC §102(e) as anticipated by U.S. Patent No. 6,726,675 to Beyar, (hereinafter referred to as "Beyar").

Applicants have amended the claims as set forth above to more clearly claim the invention. Support for the amendments can be found in the originally filed specification and originally filed claims. Specifically, claim 1 has been amended to incorporate the limitations of originally filed claim 7 and to clarify Applicants' invention. Claim 7 has been canceled. Claims 8 and 16 have been amended merely to clarify Applicants' invention. Claims 14 and 15 have been canceled. Claims 21 and 22 have been added. Support for new claims 21 and 22 can be found in paragraph [0045] of the published application. No new matter has been introduced by the amendments. Applicants respectfully request entry of the foregoing amendments and reconsideration of the amended claims for the reasons set forth below.

**Applicants have overcome the 35 USC §102 rejections of claims 1-6**

A claim is anticipated under 35 USC §102 if each claimed element is found in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

Applicants' amended claim 1 sets forth a method of manipulating an elongate member during a medical procedure, wherein the elongate member comprises a length and an axis along the length, and a base coupled to the elongate member, the method comprising:

receiving input from a user to manipulate the elongate member;

sending signals to advance the elongate member if the input directs advancement of the elongate member;

sending signals to retract the elongate member if the input directs retraction of the elongate member; and

sending signals to rotate the elongate member if the input directs rotation of the elongate member, **wherein the signals to rotate the elongate member direct a motor to rotate the base about the axis of the elongate member.**

Correspondingly, amended claim 8 sets forth an apparatus for manipulating one or more elongate members during one or more medical procedures, comprising:

a base coupled to an elongate member, **the base being capable of rotation about an axis parallel to the elongate member;**

a first motor coupled to the base that advances or retracts the elongate member along the axis; and

a second motor coupled to the base that **rotates the base**, whereby the elongate member is rotated **about the axis.**

**Beyar does not anticipate Applicants' amended claim 1 because Beyar does not disclose a base that rotates about the axis of the elongate member.**

Beyar discloses "wheels 62 and 66, which engage catheter 26 and rotate either in forward direction . . . to advance the catheter. . . or backward to retract catheter 26." (Beyar Column 6, lines 47-50.) Wheels 62 and 66 are depicted in Fig. 3 and seemingly would be capable of engaging catheter 26 in order to advance or retract it.

However, Beyar further discloses “two rollers 63 and 67 located on an axis 90° from that of wheels 62 and 66, which engage catheter 26 and rotate it around its longitudinal axis, preferably by at least +/- 180°, as shown by the arrows in the figure.” (Beyar Column 6, lines 51-55.) Beyar offers no explanation as to how substantially cylindrical rollers 63 and 67, (pictured in Fig. 3 and lying parallel to substantially cylindrical catheter 26), would be capable of engaging catheter 26 in order to rotate it. Further, if one can suppose the existence of ridges in rollers 63 and 67, or other engaging structure, catheter 26 would travel out of engagement with any such structure of rollers 63 and 67 upon rotation of rollers 63 and 67.

But most importantly, whether the rollers of Beyar are functional or not, there is no structure disclosed in Beyar which can be correlated to a *base which rotates about the axis of the catheter (or other elongate member)*. Rollers 63 and 67 do not rotate about the axis of catheter 26. Consequently, Beyar does not disclose a method wherein signals to rotate the elongate member direct a motor to rotate the base about the axis of the elongate member, (such as, for example, as illustrated in Applicants’ Figure 2, base 53), and does not anticipate Applicants’ amended claim 1 or claims 2-6 which depend therefrom.

Therefore, Applicants respectfully submit that Beyar does not disclose each element of claims 1-6 and does not anticipate Applicants’ invention of claims 1-6. Accordingly, Applicants respectfully request that the rejection based upon Beyar be withdrawn and the claims placed in condition for allowance.

**35 USC §102 is not proper grounds for the rejection of claims 8-13**

A claim is anticipated under 35 USC §102 if each claimed element is found in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

**Beyar does not anticipate Applicants’ independent claim 8 because Beyar does not disclose a base which is capable of rotation about an axis parallel to the elongate member where the elongate member is rotated about this same axis upon rotation of the base.**

Beyar does not disclose a **base that is capable of rotation about an axis parallel to [an] elongate member** where the elongate member is rotated about **this same axis** when a motor rotates the base. Applicants illustrate an example of such a base in Applicants’ Figure 2, as base 53. As described above, Beyar discloses rollers 63 and 67 in Beyar’s Figure 3.

Applicants respectfully submit that neither roller 63 nor 67 can be called a base, as a base and its function are described in Applicants' specification and claims. Granting, for the sake of argument only, that either or the combination of rollers 63 or 67 can be construed as a base, Applicants respectfully submit that rollers 63 and 67 are **not** capable of rotation about an axis of the elongate member **where upon rotation of the base, the elongate member is rotated** about the **same** axis. Consequently, Beyar does not disclose each element of claim 8 or claims 9-13 which depend therefrom. Therefore, Applicants respectfully submit that Beyar does not anticipate Applicants' invention of claims 8-13. Accordingly, Applicants respectfully request that the rejection based upon Beyar be withdrawn and the claims placed in condition for allowance.

**Conclusion**

Applicants have amended the instant application to more clearly claim the Applicants' invention. None of the foregoing amendments introduces new matter. Further, the previous bases for the Examiner's rejections have been overcome by amendment and/or argument. Accordingly, Applicants request that the foregoing amendments be entered and that the application be placed in condition for allowance. It is not believed that an extension of time is necessary. However, Applicants hereby petition for any extension of time that is needed in order to prevent abandonment of the application. Please do not hesitate to contact the undersigned in the event of any fee deficiency

Respectfully submitted,

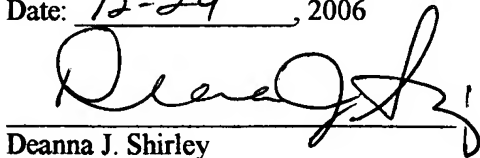


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